

Application No.: 09/867,766

REMARKS

Regarding paragraph 3 on page 2 of the outstanding Office Action, the Examiner requests clarification of the non-labeled figure submitted with the 5/15/06 amendment. The Examiner is directed to page 3, lines 10-13 of the 5/15/06 amendment, which made clear that the non-labeled figure was intended for *informational purposes* in the form of an evidentiary exhibit to help the Examiner understand the distinctions between the present invention and cited prior art (i.e., “[t]o help the Examiner better appreciate the novel and non-obvious nature of the present invention, attached hereto is an Exhibit illustrating the new and unexpected results that can be derived from the novel combination of elements recited in claims 1 and 5”). The figure was not intended to be a new drawing as part of the specification.

Claims 1 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hartung et al. in view of APA/Kasuta and Milios et al.. These rejections are respectfully traversed for the following reasons.

Claim 1 recites in pertinent part, “an address decoder which enables an operation of the comparator if the address is for the redundancy check data, and disables the operation of the comparator if the address is for the confidential data.” Claim 5 recites a similar feature in method format. One exemplary embodiment of the “address decoder” is illustrated in Figure 1 of Applicants’ drawings as ADEC 23, which can disable the operation of the comparator if the address is for the confidential data. For example, when address (0) is input, ADEC 23 can set signal AOUT2 to “L” and signal RESULT can be kept at “L” irrespective of the value OUT (CRC). On the other hand, the address decoder 23 can enable the operation of the comparator if the address is for the redundancy check data. For example, when address (2n+1) is input, ADEC

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23 can set signal AOUT2 to "H" so that COMP 26 can act and signal RESULT can be "H" (*see, e.g.,* Fig. 2 of Applicants' drawings).

Accordingly, with respect to one object of the present invention, it can be made possible to prevent the problem where signal RESULT accidentally gets "H" during a period in which the comparison should not be performed. None of the cited prior art discloses or suggests such an address decoder or a method of controlled comparison, let alone suggest the decoding of an address to control the operation of the comparator or the comparison step. Indeed, only Applicants have recognized and considered the issues related to a, for example, RESULT signal accidentally being "H" when comparison should not be performed, and conceived of a manner by which to resolve such issues. In this regard, none of the cited prior art provides any motivation for modifying the prior art construction/process to reach that of claims 1 and 5.

The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard for establishing obviousness under § 103:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejections do not "establish *prima facie* obviousness of [the] claimed invention" as recited in claims 1 and 5 because the proposed combinations fail the "all the claim limitations" standard required under § 103.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 103 be withdrawn.

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CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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